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EXAMINER

ERB, NATHAN

ART UNIT	PAPER NUMBER
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3628

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/070,265

Applicant(s)

NISHIYAMA, KOHEI

Examiner

Nathan Erb

Art Unit

3628

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 October 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-16.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s) _____.
13. ☐ Other: _____.


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER

Continuation of 5. Applicant's reply has overcome the following rejection(s): In response to applicant's amendment of claim 12, the rejection of claim 12 under 35 U.S.C. 112, second paragraph, from the previous Office action is hereby withdrawn.

Continuation of 11. does NOT place the application in condition for allowance because: In light of applicant's amendment of the claims, all of the claim objections from the previous Office action are hereby withdrawn.

In response to applicant's amendment of claim 12, the rejection of claim 12 under 35 U.S.C. 112, second paragraph, from the previous Office action is hereby withdrawn.

With respect to the prior art rejection of claim 1, applicant first argues that Henson does not disclose the element/limitation of "fundamental information presenting mechanism for presenting fundamental information concerning a commodity under development to an answerer" because the computer being customized in Henson is not a commodity under development. In support of this argument, applicant states: "However, Applicant emphasizes that Henson merely discloses selecting a combination of components not selecting specifications determining the manufacture of a product. The components shown in Figures 3A, 3B, 4 and 5, are components that are separately available for purchase and can be installed or connected to a computer by a user. Henson merely provides a convenience of packaging these components together." Examiner disagrees that the fact that customer-provided specifications may be simply the selection of what modular components are to be installed in an item negates that the item is a commodity under development. As Examiner stated in the previous Office action, p. 3: "Examiner believes that the customizable computers of Henson can be considered to be commodities under development for the following reasons. First, in view of Figures 3A, 3B, 4, and 5, we see that Henson discloses at least eighteen parameters of a computer that can be configured: memory, hard drive, monitor, video card, CD-ROM drive, sound card, speakers, storage products, operating system, bundled software, modem, network card, keyboard, service, printers, scanners, power protection, and software and accessories. Even if each parameter were only allowed to vary between two possible choices, that would still result in 2^{18} , or 262,144, possible computer configurations. Even if some of these configurations are not presented due to compatibility constraints, there is still a substantial potential for a multitude of possible configurations. Furthermore, the number of possible configurations increases even further if more parameters are added or if additional choices are offered for a given parameter. Thus, it is quite possible for a customer to customize a computer which has never actually been specifically specified or built before; therefore, such a computer could not have been previously developed." Specifying the amount of memory to be installed in one's computer is as much a manufacturing specification as the size and shape of the computer's outer casing, and assembling components into a finished product is still manufacturing, even if particular components may be interchangeable for each other. In fact, manufacturing generally encompasses any kind of assembly of component parts into a finished product. As addressed in the previous passage, with so many possible combinations of customer choices for computer specifications in Henson, there is plenty of potential for a customer to specify a computer product configuration that has never been specified before. It should also be reiterated that the invention of Henson is not contemplating sending the customer's selected components to the customer physically separate from each other for the customer to assemble upon receipt. For example, Henson, when discussing shipping delay notification on its website, column 7, lines 6-11, states: "In other words, the shipment delay indicator provides the customer with advance notice that a particular selected option or options will result in a shipment delay. For example, a shipment delivery may be adversely affected in that the lead time or shipment is delayed from a one week build and delivery to five weeks." Therefore, the assembly of the computer occurs on the seller side of the transaction and not the customer side of the transaction. Therefore, applicant's arguments are not persuasive with respect to this issue.

Applicant next argues with respect to the prior art rejection of claim 1 that the prior art does not disclose the element/limitation of "wherein said answer provides quantitative information regarding the future demand of the commodity under development" because Van Horn et al. does not describe a "commodity under development." Examiner disagrees. Van Horn et al., column 4, lines 11-23, states: "In addition, the invention permits buyers to help choose which products and brands will be featured in future co-ops. Through this feature, buyers also can actually create a market for a particular product. For example, this input feature would permit a general query regarding whether there is sufficient buyer interest for a particular style of wristwatch (in which one or more buyers had previously inquired). If sufficient demand for the item exists, a business entity implementing the invention could then seek out a jewelry manufacturer willing to make a large volume of the watches and then offer such items to those who expressed interest and potentially others in a future co-op." Van Horn et al., column 5, lines 13-18, further states: "Further, this invention enables the feasible collection of various other types of market data such as geographic distribution and other characteristics of the buyers interested in a given product. In addition, it enables a superior way to gauge interest in future products and services." Van Horn et al., column 9, lines 45-57, states: "In addition to participating in co-ops, buyers may utilize an input feature to suggest products or product categories for which they have an interest in a co-op being created. Further information is gathered regarding the buyers preferences including acceptable price, and such person is then notified at the time his or her items are sold by co-op. Other aspects of this function include a focal point or community for buyers to suggest and organize a wide variety of co-ops designed to suit their every need, including the ability to create sufficient demand to support purchases, the specific manufacture of particular products suggested by the various buyers, or the creation of broader interest groups around a category of products." The previous passages from Van Horn et al. indicate that the potential buyers are suggesting and expressing interest in products that have not yet been manufactured and future products. Such products would be "commodities under development." Therefore, applicant's arguments are not persuasive with respect to this issue.

Applicant next argues with respect to the prior art rejection of claim 1 that there is not a reasonable expectation of success upon the combination of the references and that Henson teaches away from modifying a method or system disclosed therein based upon disclosures of Van Horn et al. In support of these arguments, applicant states in p. 7 of applicant's response: "Henson provides a system that allows a user to determine a price from a combination of computer components, not to enter a price that the user is willing to pay for the combination of computer components." Applicant further states in p. 7 of applicant's response: "Meanwhile, Van Horn discloses a co-op in which members can input the maximum acceptable price that they are willing to pay for a product. The user would be would like to buy the computer of Henson at the low price and would not honestly input the upper limit value of the price that the user is willing to pay." The concept of "reasonable expectation of success" is discussed in MPEP 2143.02, which states: "The prior art can be modified or

combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success." MPEP 2143.02 further states: "Obviousness does not require absolute predictability, however, at least some degree of predictability is required. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness." MPEP 2143.02 further states: "Whether an art is predictable or whether the proposed modification or combination of the prior art has a reasonable expectation of success is determined at the time the invention was made." The motivation provided by Examiner for modifying Henson with Van Horn et al.'s element/limitation of "wherein said answer provides quantitative information regarding the future demand of the commodity under development" was "such information could allow a business entity to determine if sufficient buyer interest exists to manufacture a product and to identify future buyers of the new product." Examiner believes that there was at least some degree of predictability and that there was a reasonable expectation of success that the product-specifying information collected in Henson could be used not just to specify a product to be immediately built, but also products to be manufactured further into the future. The fact that there may be some particular differences between the inventions of Henson and Van Horn et al. does not necessarily mean that there was no reasonable expectation of success to combine the particular element/limitation of Van Horn et al. of "wherein said answer provides quantitative information regarding the future demand of the commodity under development" with Henson, and Examiner does not believe any particular differences between Henson and Van Horn et al. interfere with the addition of that particular element/limitation to Henson.

Regarding the "teaching away" argument, with respect to "teaching away," MPEP 2141.02(VI) states: "However, 'the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....'" Examiner does not know of any particular disclosure of Henson which specifically criticizes, discredits, or otherwise discourages the modification of Henson such that said answer provides quantitative information regarding the future demand of the commodity under development. Applicant's asserted differences between Henson and Van Horn et al. do not seem to do so. Therefore, applicant's arguments are not persuasive with respect to these issues.

With respect to the prior art rejection of claim 7, applicant disagrees with the combination of Henson and Van Horn et al. because the two references would accomplish exclusive goals. By this, applicant means that Henson is directed toward a customer customizing his or her computer while Van Horn et al. is attempting to aggregate purchases for a particular item. Examiner disagrees that these are necessarily exclusive goals. First, as Examiner discussed in the previous Office action, the user who originally specifies a product that is to be the object of price offers from multiple different users would still be choosing that user's exact desired product specifications. Therefore, those users who truly require that they exactly customize their product can make the initial product suggestion in Van Horn et al. Van Horn et al. then allows the aggregation of other purchasers interested in purchasing the product as already suggested by a user. This allows for the aggregation of buyers that provides the increase in volume of product sold that is sought by Van Horn et al. So, the combination of Henson and Van Horn et al. provides the best of both worlds: the users who want to specify exactly what they want can do so, and the users who are not quite so selective can serve to increase the volume of the buyers for such specified products so that they become profitable to manufacture. Therefore, applicant's arguments are not persuasive with respect to this issue.

Applicant next argues with respect to the prior art rejection of claim 7 that Henson recognizes the importance of lead time and therefore would not be willing to risk an increase in lead time from the combination of Van Horn et al.'s teachings with Henson. Examiner responded to this argument in the previous Office action, p. 6, by stating: "Second, while combining Van Horn et al. may increase lead time, the main focus of Henson's method is the ability to choose a particular exact configuration, not the reduction of lead time. In addition, the positive effect of being able to sell the same configuration to multiple users may well outbalance any negative effect on lead time." While Examiner admits that portions of Henson discuss the significance of lead time to a purchase, Examiner reiterates that the main focus of Henson's method is the ability to choose a particular exact configuration, not the reduction of lead time. For example, the title of Henson is "Method and Apparatus for Providing Customer Configured Machines at an Internet Site." This title focuses on the ability of the customer to customize the computer, as well as that the sale may occur over the Internet. The title is not something along the lines of "Method and Apparatus for Reducing Lead Time for Internet Sales." In addition, Examiner reiterates that the positive effect of being able to sell the same configuration to multiple users may well outbalance any negative effect on lead time. Therefore, applicant's arguments are not persuasive with respect to this issue.

With respect to the prior art rejection of claim 8, applicant argues first that it would be unobvious to modify the system of Henson to include a function of, if it is not expected as a result of the comparison operation that an appropriate amount of profit will be generated, transmitting, to each purchase wishing person, a message requesting the answerer to increase the desired purchasing prices. In support of this argument, applicant asserts that, since Henson calculates computer price based on customer specifications, a customer would simply choose his or her options based on displayed price and thus it would then be undesirable to then ask the customer to pay a higher price. However, note that the rejection of claim 8 incorporates by dependency the rejection of claim 7, in which Henson was modified to add the element/limitation of "wherein the computer is provided with a commodity price calculating mechanism, which provides the answerer with a commodity price calculated on the basis of volume of items to be sold and a cumulative number of purchase candidates." With this modification, Henson is transformed from a system in which a given computer configuration has a set price to one in which the price can vary based on sales volume. In this context, it is conceivable that a seller would want to request a buyer to increase the buyer's desired purchase price, so that seller can insure that the variable price does not end up less than would allow seller to make seller's required level of profit. Therefore, applicant's argument is not persuasive with respect to this issue.

With respect to the prior art rejection of claim 8, applicant further argues that Henson merely refers to a transaction at a single price while applicant's invention allows price to change over a range. In response, Examiner admits that Henson alone does not disclose all of the elements/limitations of claim 8. However, Examiner believes that the prior art combination described in the rejection for claim 8 does. Therefore, applicant's arguments are not persuasive with respect to this issue.

With respect to the prior art rejections of claims 9 and 11, applicant argues that the prior art does not disclose "receiving, from said plurality of user terminals, votes concerning the specifications and image information displayed on said Web page" because Van Horn et al. only allows the expression of interest in a product, not voting for specifications and image information. Van Horn et al., column 4, lines 11-24, states: "In addition, the invention permits buyers to help choose which products and brands will be featured in future co-ops.

Through this feature, buyers also can actually create a market for a particular product. For example, this input feature would permit a general query regarding whether there is sufficient buyer interest for a particular style of wristwatch (in which one or more buyers had previously inquired). If sufficient demand for the item exists, a business entity implementing the invention could then seek out a jewelry manufacturer willing to make a large volume of the watches and then offer such items to those who expressed interest and potentially others in a future co-op." As can be seen from that passage, Van Horn et al. allows the user to express interest in a particular style of product. In such a case, the specifications that define that particular watch style would be specifications in which the user is expressing interest. Information being image information is disclosed in Matsuzaki et al., as described in the rejection for these claims. See the rejection for these claims in the previous Office action for details. Therefore, applicant's arguments are not persuasive with respect to this issue.

With respect to the prior art rejections of claims 9 and 11, applicant further argues that Matsuzaki et al. and Van Horn et al. cannot be combined because one skilled in the art would not know how to allow voting on image information. Examiner disagrees. In the above paragraph, Examiner discussed how Van Horn et al. discloses the expression of user interest in particular specifications. Images are just another form of information, like specifications. Displaying images on computer screens was well-known in the art at the time of applicant's invention, and since Van Horn et al. was able to measure user interest in particular specifications, it would not be difficult for one skilled in the art at the time of applicant's invention to display image information in the system of Van Horn et al. and allow users to express interest based on those images of products as well. Therefore, applicant's arguments are not persuasive with respect to this issue.

Applicant also stated that there was no reasonable expectation of success to combine the references in the rejection for claims 9 and 11 but did not provide further discussion specifically with respect to reasonable expectation of success. Therefore, Examiner simply asserts that the expected benefits of the combinations that were suggested by the stated motivations to combine in the rejection would have reasonably and predictably been present in the resulting combinations. Therefore, there was a reasonable expectation of success, and applicant's arguments are not persuasive with respect to this issue.

With respect to the rejections of claims 10 and 12, applicant argues that Van Horn et al. fails to disclose "in order to determine financial risk regarding the production of the commodity." Examiner disagrees. As discussed in the rejection for claims 10 and 12, Van Horn et al. calculates demand forecast and a planned selling price. These two quantities together indicate financial risk because their product equals expected revenue. Therefore, financial risk is determined in Van Horn et al, and applicant's arguments are not persuasive with respect to this issue.